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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/423,525 11/10/99 FALLESEN

B PATRADE

EXAMINER

IM52/1005

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YAD, S
ART UNIT

PAPER NUMBER

1733
DATE MAILED:

10/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/423,525

Applicant(s)

PALLESEN, BODIL ENGBERG

Examiner

Sam Chuan C. Yao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I (claims 1-9) in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the national stage was incorrectly restricted using PCT rules instead of using the US restriction practice as stated in MPEP 802,802,806; and examiner has not shown burden. This is not found persuasive because a national stage application is examined under lack of unity practice (PCT Rule 13.1), and not under US restriction practice as shown in section 1893(d) of the MPEP. Although it is not required to show burden under PCT rule, it is submitted that, it would be a serious burden on the examiner to consider 3 divergent groups of inventions, where each group would require different searches.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

2. The information disclosure statement filed on 11-29-99 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. Some of the cited foreign patents were not considered because not only they were not cited in a search report, but they also do not have any statement of relevancy or English translations.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is unclear which portions of the recited limitations are intended to be a preamble and a body of the claim. Moreover, it is also unclear what process step is required to pre-treat the fibers? Is it the "cutting and threshing" of plants (note the phrase "the plants" does not have a positive antecedent basis) or the wholly or partially retting of plant stems? It also not clear what materials are being shortened and separated to form fiber mass? What is intended by the phrase "single fibres"? Does this phrase require one fiber or a plurality of fibers? Moreover, is drying step required in this claim or merely an optional step? Note further that the phrase "the mat" does not also have a positive antecedent basis. What is intended by the limitation "... as these are more or less fibrillated"?

Claim 2 is indefinite because, claim 1 would appear to require a shortening process being performed after the recited pretreatment process. If this is the case, how is it possible to obtain a shorter fiber length during the pretreatment process than a further shortening step? This claim also requires a broad range or limitation followed by linking terms (e.g., preferably, maybe, for instance, for example, especially) and a

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narrow range or limitation within the broad range or limitation, rendering the claim indefinite, since it does not clearly define the metes and bound of the invention.

Claim 3 is indefinite because it is not clear whether a process of performing a controlled retting of fibers in water containing enzymes is an optional process step or not.

Claim 6 is indefinite because the phrase "the fibre fraction" does not have a positive antecedent basis.

Claim 9 is indefinite because the phrase "that they are treated chemical, for example by adding base, that they are washed and that they are dried" (emphasis added) is confusing. Does this phrase modify the pretreatment of fibers under a pressured boiling water or only modify the pretreatment of fibers in an extruder? The phrase "boiled in an extruder" is confusing. What material is being boiled in an extruder? The recitation of a linking term "for example" also renders the claim indefinite for the same reason as claim 2.

5. The recited claims are replete with 112 2nd paragraph problems. The lack of a prior art rejection should not be construed as meaning that the claims would be patentable if corrected to overcome the 35 USC 112 rejection set forth above. No prior art rejection has been made since it would be improper to rely on speculative assumptions as to the meaning of the claims in this application.

It is suggested to amend all claims to conform with US claim drafting practice.

For instance, use active voice and use transitional phrases such as "consisting of" (closed), "comprising" (open) to all claims.

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (703) 308-4788. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7115 for regular communications and (703) 305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

scy
October 4, 2001